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Atty. Ref.: 1035-650
Amendment
July 15, 2008

REMARKS

Reconsideration is requested.

The specification has been revised to include the attached substitute specification in place of the originally-filed specification. A marked-up copy of the attached substitute specification is also attached showing the changes. The applicants believe that no new matter has been added. With specific regard to the change of "tanatalum pentoxide" to "tantalum nitride", the applicants note that the former is an insulating material. Moreover, the attached deletes the full paragraph on page 74 of the originally-filed specification and inserts a copy of the full paragraph on page 130 of the originally-filed specification as the Manufacturing Example 2 is not a monocrystal silicon, but a polycrystalline silicon as in Manufacturing Example 3. The applicants believe that no new matter has been added.

Claims 4-7, 9-18 and 20-34 are pending. Claims 1-3, 8 and 19 have been canceled, without prejudice.

The indication that claims 4, 5, 7-10 and 13-15 contain allowable subject matter is acknowledged, with appreciation. See page 6 of the Office Action dated April 15, 2008. The Examiner has separately rejected claim 8 as allegedly having been obvious while also indicating claim 8 would be allowable if amended to include the details of any claims from which it depends. Claim 8 has been canceled, without prejudice, to advance prosecution.

Claims 23-34 have been withdrawn from consideration as being drawn to a non-elected "species". The Examiner states in the Office Action of February 14, 2008 that

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prosecution on the merits will be restricted to the elected species if no generic claims are finally held to be allowable. Examination and allowance of all of the claimed subject matter are requested as the claims of the elected species are believed to be allowable for the reasons noted herein.

The objection to claim 2 is moot in view of the above.

The Section 102 rejection of claims 1-3, 6, "12-12", 21 and 22 over Koizumi (U.S. Patent No. 7,156,962) and the Section 103 rejection of claims 8 over Koizumi in view of Sato (U.S. Patent No. 6,468,663) and the Section 103 rejection of claim 16 over Koizumi in view of Tsuzuki (U.S. Patent No. 7,122,264) and the Section 103 rejection of claims 17-20 over Koizumi in view of Kato (U.S. Patent Application Publication No. 2005/0036382 A1) are traversed. Reconsideration and withdrawal of the rejections are requested in view of the following distinguishing comments.

Withdrawal of the rejections are requested as the cited Koizumi patent is not citable under Section 102(e). The earliest date that the cited Koizumi patent may be relied upon as a reference in the U.S. is the January 22, 2004 publication date of U.S. Patent Application Publication No. 2004/0011665.

The Examiner is requested to appreciate that the cited U.S. patent is not citable as a reference under 35 U.S.C. § 102(e)(1) or 35 U.S.C. § 102(e)(2). Specifically, the cited patent is understood to be the 371 U.S. national phase of PCT/JP02/06086 which published as WO03/000957 in Japanese, as shown in the following reproduction of the first page of WO03/000957:

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(22)国際出願日: 2002年6月19日 (19.06.2002)

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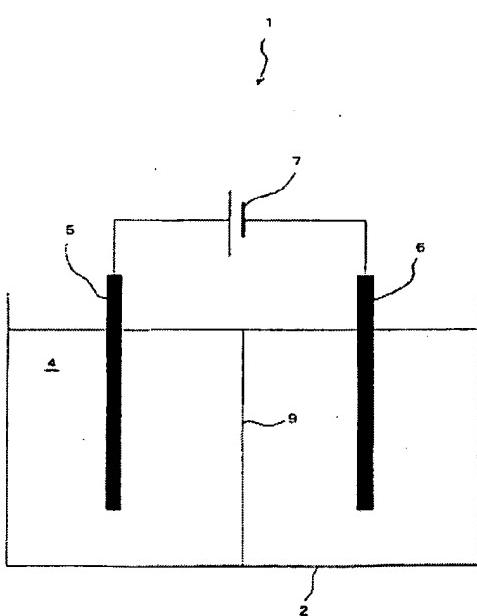
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/焼葉有/

(54) Title: ELECTROLYZING ELECTRODE AND PRODUCTION METHOD THEREFOR AND ELECTROLYSIS METHOD
USING ELECTROLYZING ELECTRODE AND ELECTROLYSIS SOLUTION PRODUCING DEVICE

(54)発明の名称: 電解用電極及びその製造方法及び電解用電極を用いた電解方法及び電解水生成装置

(57) Abstract: An electrolyzing electrode which is friendly to human body safety and to the environment at disposing, efficiently produces ozone, and is excellent in durability, a production method therefore, and an active oxygen generator using the electrolyzing electrode. An electrolyzing electrode (5) provided on at least the surface thereof with an electrode catalyst, for producing ozone or active oxygen in an untreated water by electrolyzing, wherein the electrode catalyst contains a dielectric, with the dielectric accounting for in surface area more than 70% of the electrode catalyst.



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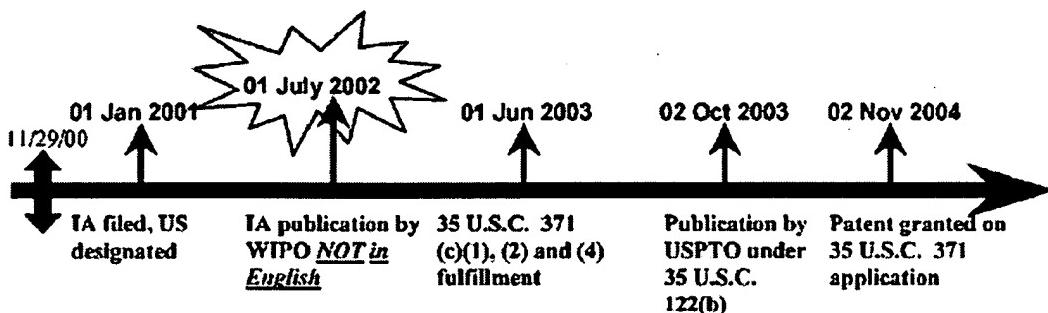
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The Examiner will appreciate that MPEP § 706.02(f)(1), and specifically Example 5 of the same which is reproduced below as available from www.uspto.gov on March 12, 2008, confirms that under the circumstances presented by U.S. Patent No. 7,156,962 (i.e., a U.S. patent issued from a U.S. national phase of an International Application filed after November 29, 2001 where the International Application was not published in English) the International Application publication is not citable under Section 102(e), the USPTO publication of the application is not citable under Section 102(e) and the U.S. patent granted on the same is not citable under Section 102(e).

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Example 5 : References based on the national stage (35 U.S.C. 371) of an International Application filed on or after November 29, 2000 and which was not published in English under PCT Article 21(2) .

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000 but was not published in English under PCT Article 21(2) have no 35 U.S.C. 102 (e) prior art date at all. According to 35 U.S.C. 102 (e), no benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102 (e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English, regardless of whether the international application entered the national stage. Such references may be applied under 35 U.S.C. 102 (a) or (b) as of their publication dates, but never under 35 U.S.C. 102 (e).



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None. The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None. The 35 U.S.C. 102(e)(2) date for the Patent is: None.

The IA publication by WIPO can be applied under 35 U.S.C. 102 (a) or (b) as of its publication date (01 July 2002).

Additional * Benefit Claims :

If the IA properly claimed ** > the benefit of < to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102 (e) date for all the references.

If a later-filed U.S. nonprovisional (35 U.S.C. 111 (a)) application claimed the benefit of the IA in the example above, the 35 U.S.C. 102 (e) date of the patent or publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application.

The text of the MPEP preceding the Example reproduced above further explains the 102(e) effect of such a patent as follows:

(2) If the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do not apply the reference as of its international filing date, its date of

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completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

The presently claimed priority applications were filed prior to the January 22, 2004 publication of U.S. Patent Application Publication No. 2004/0011665.

In view of the above, the applicants submit that U.S. Patent No. 7,156,962 is not citable under 35 U.S.C. § 102(e) and withdrawal of the Section 102 and Section 103 rejections of the claims based on the same is requested.

For completeness and to advance prosecution, the applicants note that WO 03/000957 was published January 3, 2003, i.e., before the filing of the presently claimed priority applications. The claimed invention is patentable over WO 03/000957, as presented in the form of U.S. Patent No. 7,156,962 as an alleged English equivalent text. Consideration of the following in this regard is requested.

Claims 4-7, 9-18 and 20-22 have been revised above, without prejudice, to place claims 4-7, 9-18 and 20-22 in condition for allowance. A Notice of the allowance of at least claims 4-7, 9-18 and 20-22 is requested.

The rejections are moot with regard to the canceled claims.

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned in the event anything further is required in this regard.

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Respectfully submitted,

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